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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/734,792  | 12/12/2003  | Erwin Hacker         | 514413-3869.1       | 3467             |
| 20/999 7590 07/07/2010<br>FROMMER LAWRENCE & HAUG<br>745 FIFTH AVENUE- 10TH FL.<br>NEW YORK, NY 10151 |             |                      |                     |                  |
| EXAMINER  |             |                      |                     |                  |
| QAZI, SABIHA NAIM   |             |                      |                     |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
| 1612  |             |                      |                     |                  |
| MAIL DATE   |             | DELIVERY MODE        |                     |                  |
| 07/07/2010  |             | PAPER                |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/734,792

**Applicant(s)**

HACKER ET AL.

**Examiner**

Sabiha Qazi

**Art Unit**

1612

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 4/14/10.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3, 6-9 and 12-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3, 6-9 and 12-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI.08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

Claims 3, 6-9 and 12-22 are pending.

***Election/Restrictions***

- I. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 3, 6, and 12-22 are drawn to a herbicide combination comprising a synergistically effective amount of components (A) and (B), wherein component (A) comprises a compound of the formula (II), (III), (IV), (V) and X, B comprises a list of compounds disclosed in claims.
- II. Claim 7-9, drawn to method for controlling harmful plants, which comprises applying the herbicides of the herbicide combination together or separately, pre-emergence, post-emergence or pre- and post-emergence, to the plants, parts of plants, plant seeds or the area under cultivation wherein the herbicide combination comprising a synergistically effective amount of components (A) and (B), wherein component (A) comprises a compound of the formula (II), (III), (IV) and (V) as in group I.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and inventions II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case product as claimed can be used in materially different process.

Claim 19. A herbicide combination comprising a synergistically effective amount of components (A) and (B), wherein component (A) comprises a compound of the formula (II), (III), (IV) and (V), where the compounds are

which is unsubstituted or substituted by one or more radicals selected from the group consisting of halogen, cyano, nitro, thiocyanato, (C1-C4)-alkoxy, (C1-C4)-alkylthio, (C1-C4)-alkylsulfinyl, (C1-C4)-alkylsulfonyl, (C2-C4)-alkenyl, (C2-C4)-alkynyl, phenyl, which is unsubstituted or substituted, and heterocyclyl having 3 to 6 ring atoms and 1 to 3 hetero ring atoms selected from the group consisting of N, O and S, the ring being unsubstituted or substituted,

R2 and R3

in each case independently of one another are hydrogen, amino or alkylamino or dialkylamino having in each case 1 to 6 carbon atoms in the alkyl radical, an acyclic or cyclic hydrocarbon radical or hydrocarbonoxy radical having in each case 1 to 10 carbon atoms or a heterocyclyl radical, heterocyclyloxy radical or heterocyclylamino radical having in each case 3 to 6 ring atoms and 1 to 3 hetero ring atoms selected from the group consisting of N, O and S, where each of the five last-mentioned radicals is unsubstituted or substituted, or an acyl radical or

R2 and R3 together with the nitrogen atom of the group NR<sub>2</sub>R<sub>3</sub> are a heterocyclic radical having 3 to 6 ring atoms and 1 to 4 hetero ring atoms, where the further hetero ring atoms which are optionally present in addition to the nitrogen atom are selected from the group consisting of N, O and S and the radical is unsubstituted or substituted,

Application/Control Number:  
10/734,792  
Art Unit: 1612

Page 4

R4 is hydrogen, amino, alkylamino or dialkylamino having in each case 1 to 6 carbon atoms in the alkyl radical, an acyclic or cyclic hydrocarbon radical or hydrocarbonoxy radical and many more substituents

and

(B) is one or more herbicides selected from the group of compounds consisting of

(B 1) foliar- and/or soil-acting herbicides which are active against monocotyledonous harmful plants selected from the group consisting of

(B 1.1.1)

isoproturon,

(B 1.1.2)

chlorotoluron,

(B1.2.1)

flufenacet,

(B 1.2.2)

pendimethalin,

(B 1.2.3)

prosulfocarb,

(B1.3.1)

clodinafop-propargyl,

(B 1.3.2)

diclofop-methyl,

Application/Control Number:  
10/734,792  
Art Unit: 1612

Page 5

(B1.3.3)

fenoxaprop-P-ethyl and fenoxaprop-ethyl,

(B1.3.4)

quizalofop-P and its salts and esters and quizalofop and its salts  
and esters,

(B1.3.5)

fluazifop-P and its esters and fluazifop and its esters,

(B 1.3.6)

haloxyfop and haloxyfop-P and their esters,

(B1.3.7)

propaquizafop (PM, p. 1021-1022),

(B1.3.8)

cyhalofop and its esters,

(B1.4.1)

sethoxydim,

(B1.4.2)

cycloxydim

(B1.4.3)

clethodim,

(B1.4.4)

Application/Control Number:  
10/734,792  
Art Unit: 1612

Page 6

clefoxidim,

(B1.4.5)

tralkoxidim,

(B 1.5.1)

dimethenamid,

(B 1.5.2)

pentoxamid,

(B1.5.3)

butachlor,

(B1.5.4)

pretilachlor,

(B 1.6.1)

imazamethabenz-methyl

(B1.6.2)

simazin

(B1.6.3)

molinate

(B 1.6.4)

thiobencarb

(B1.6.4)

MY 100,

(B1.6.5)

anilofof,

(B1.6.6)

cafenstrole,

(B1.6.7)

mefenacet,

(B 1.6.8)

fentrazamid,

(B1.6.9)

thiazopyr.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions require a different field of search (for example, searching different electronic resources, or employing different search queries);
- (b) the prior art applicable to one invention would not likely be applicable to another invention;
- (c) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.



Application/Control Number:  
10/734,792  
Art Unit: 1612

Page 8

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. Applicant is requested to elect a single combination as elected species for the search purposes. Elected species should contain one single compound of the component A and one single compound of the component B. Election of species applies in the same way if Applicant elects group II.

If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

No call was made for the restriction.<sup>1</sup>

The examiner has required restriction between product and process of using the claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder.

All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined. In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C.

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<sup>1</sup> Election/Restriction is made after the decision in pre-appeal conference. The previous examiner Mark Clardy requested the election of species earlier in the prosecution. The panel decided to send the restriction as was requested by the Applicants in pre-appeal.

Application/Control Number:  
10/734,792  
Art Unit: 1612

Page 10

121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

#### **Communication**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha Qazi whose telephone number is (571) 272-0622. The examiner can normally be reached on any business day except Wednesday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Krass Frederick can be reached on (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sabiha Qazi/

Application/Control Number:  
10/734,792  
Art Unit: 1612

Page 11

Primary Examiner, Art Unit 1612